

No. 3860

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IN THE

United States Circuit Court of Appeals

For the Ninth Circuit

JOSEPH HOTCHNER,
Appellant,

VS.

FEDERAL ELECTRIC COMPANY
(a California corporation),
Appellee.

On Hotchner Patents:

1,259,237—March 12, 1918

1,315,187—September 2, 1919,

Illuminated Signs.

JOSEPH HOTCHNER,
Appellant,

VS.

R. E. MORGAN and P. C. LONG,
Appellees.

BRIEF FOR APPELLEES.

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BRIEF FOR APPELLEES.

This appeal embraces two suits against two different sets of defendants and involving different structures of different manufacturers. It was agreed that the two cases might be tried together (R. 33).

While the showing of alleged infringement by the Federal Electric Company in case No. 577 is based largely on guess-work and hearsay, there was almost a total lack of evidence going to show what the defendants Morgan and Long in case No. 507 were charged to be guilty of. We may for the purpose of this appeal assume that the structures of the different defendants are substantially the same.

The entire record of plaintiff-appellant aptly illustrates the admonition of the Court of Appeals for the 3rd Circuit in *Fried Krupp Aktien-Gesellschaft v. Midvale Steel Co.*, 191 Fed. 588:

“We deem it proper, however, to say for the guidance of patent practitioners in this circuit that it should be borne in mind that infringement is not only a question of fact, but is a tort or wrong, the burden of establishing which, as in all torts, clearly rests on those who charge such wrong. The absence of actual fact proof is not met by the presence of expert speculations no matter how voluminous.”

The plaintiff's bill of complaint charged infringement of two patents issued to the plaintiff, both relating to electric signs. The cases were tried in open court before Judge Rudkin who, after hearing the evidence and having opportunity to observe the witnesses, dismissed the bills for lack of equity.

The features of defendant's signs which plaintiff asserts constitute an infringement of his patents are so common-place that the trial Judge expressed great amazement that anyone would assert that

they were within the protection of an existing patent.

Defendant's sign, which plaintiff contends infringes his first patent, namely, Patent No. 1,259,-237, of March 12, 1918, is exemplified by defendant's Exhibit W. It is made as follows: An opening of the shape of a letter is cut in a piece of sheet metal. A raised strip of molding is placed around the border of this opening solely for the sake of adornment and back of this opening is a plain sheet of glass or translucent material to let the light shine through. The court, after hearing the *prima facie* proofs of plaintiff was reluctant to believe that plaintiff's charge of infringement was based on the use of so common an expedient and the court made further inquiry as follows:

"The COURT. What is it the plaintiff claims under his patent—the exclusive right to use this? .

Mr. TOWNSEND. Apparently, from the *prima facie* case, they claim any sort of a beveled border as an infringement.

Mr. GRIFFIN. We claim the right to use any kind of a raised metal molding.

The COURT. And you claim no one else has a right to use it.

Mr. GRIFFIN. We claim no one else has the right to use the metal molding in connection with this translucent letter with the illumination in the back of the character," (Record p. 239.)

The structure which plaintiff asserts infringes his second patent, namely, No. 1,315,187, dated September 2, 1919, is shown by defendant's Ex-

hibit EE. It consists merely in arranging a trough-shaped reflector on the bottom of an interiorly lighted sign and placing a row of lamps in this reflector so that light will be reflected down on to the sidewalk. The proofs show that this has been required by the City Ordinances of various municipalities for many years prior to the filing date of the patent. The court very properly at the close of the trial ruled as follows:

“The COURT. The claim that a person in this day and age can gain a monopoly on the right to use raised letters in an electric sign, or upon the mere mode employed to throw rays of light from such sign upon a sidewalk, is, to my mind, utterly unfounded.

The complaints in both cases are, therefore, dismissed.”

The fallacy of plaintiff's case lies in this: He is grossly mistaken as to what his first patent covers, and, in regard to his second patent, he is mistaken as to what defendant is making and selling.

The defenses are:

I. With respect to Hotchner Patent No. 1,259,-237, hereinafter called the “raised molding sign”:

- (1) Non-infringement, and
- (2) Invalidity on account of
 - (a) anticipation by prior use and prior patents;
 - (b) introduction of new matter into the application after filing.

II. With respect to Hotchner Patent No. 1,315,187, hereinafter called the "sidewalk illumination sign":

- (1) Non-infringement, and
- (2) Invalidity on account of
 - (a) lack of invention in view of the state of the prior art, and
 - (b) aggregation.

Re: Patent No. 1,259,237, dated March 12, 1918: (Raised Molding Sign).

Plaintiff declares on but one claim of this patent, to wit, claim 4. That claim is as follows:

A sign comprising:

(1) A sheet metal body with a raised molding formed therein to define a character.

(2) A sheet of translucent material covering the entire area of the space bounded by the greatest length and breadth of the letter back of the same.

(3) The edges of the molding toward the center of the elements of the letter *lying substantially in contact with the translucent material*.

(4) And means to illuminate the translucent material and through which the light shines.

This claim was woven into the application some 2½ years after the filing of the application. Plainly, it requires with respect to condition or element (3) that the edges of the molding *contact* with the sheet of glass, in other words, an overhanging molding, as shown in Figs. 2 and 4 of the patent, and em-

bodied in defendant's Exhibits "X" and "Y", which plaintiff's counsel admitted to be correct representations of the drawings of this patent (R. 252 and 253).

Non-Infringement.

Defendant's sign, as will be seen by an inspection of defendant's Exhibit W, does not have a raised molding, the edge of which *contacts* with the glass or translucent material. This molding is turned outwardly and its edge lies not against the glass, but against the sheet metal body. In other words, Hotchner's molding forms a support or rest for the glass, whereas defendant's molding is merely for ornamental effect and the glass contacts only with the sheet metal body or frame of the letter.

It thus appears that even if claim 4 be valid, it is not infringed by defendant.

However, this claim is invalid for two reasons:

(a) It departs from the disclosure of the Hotchner drawings and specification; in fact, it is inconsistent with the teachings of the Hotchner patent, and

(b) It is invalidated by prior patents and prior public uses.

Re: New Matter:

The court will notice that this claim specifies particularly that the sheet of translucent material shall cover "*the entire area of the space bounded by the greatest length and breadth of the letter*

back of the same.” Now, it is a very simple matter to demonstrate that a rectangular piece of glass cannot, with but the single exception of the letter “I,” be applied to the Hotchner construction as shown and described in the said patent. In each and every example shown in the drawings and described in the specification of this patent, as originally filed, the glass is “held in place in the plane of the sheet metal front.” (see lines 53-55 in the Hotchner patent.) This applies as well to Fig. 2 as to Fig. 4 and is so stated in claims 1, 2 and 3.

The drawings as originally filed and as they now appear in the Hotchner patent show a structure wherein the sheet metal front is cut away in the shape of a letter and is formed with a raised border or molding, with a piece of glass or translucent material inserted in the cut away space and lying *in the plane of* the sheet metal front. This construction is clearly described and claimed, especially in original claim 3 which called for “a sheet of translucent material adjacent said molding resting *in a pocket* formed by the letter plate.” The disclosure was made even more particular in these respects by subsequent amendments both to the claims and specification. In a letter dated June 27, 1916, the Examiner said:

“The claims should be amended to call for a box provided with a front and to state that the translucent material is *in the plane of the front*. The specification should support the statement ‘in the plane, etc.’”

Accordingly the specification was revised to read as follows:

“This molding is pressed outwardly *far enough* so that a suitable sheet of translucent material 13 may be inserted under the molding and is held in place *in the plane of* the sheet metal front 10 by strips of sheet metal 14.”

Taken in connection with the drawing this can mean but one thing, namely, the glass or translucent material is laid within *a pocket* so that it intersects *the plane of* the sheet metal front, and in order to do so the glass must be cut in the exact shape of the letter. The first three claims of the patent all require the translucent material to be arranged *in the plane of the sheet metal front* and consequently such claims apply only to a sign wherein the translucent material or glass is cut in the *exact form* of the letter to be produced.

However, claim 4 calls for an entirely different structure and one in which the translucent material or glass is in the form of a blank sheet “covering the entire area of the space bounded by the greatest length and breadth of the letter.” This claim was an after-thought, and did not make its appearance until January 9, 1917, more than two years after the original application was filed. Prior to this amendment the specification and drawings lacked any reference whatever to a blank sheet of translucent material cut in the form of the letter so that it might be laid into the pocket formed in the front of the sheet metal body.

Claim 4, therefore, is for new matter and can find no support whatever in the original specification and drawings. It was not submitted until long after Hotchner had filed his original application and at a time when other signs had already made their appearance wherein a blank sheet of glass was used in place of one cut in the shape and form of the letter. In an endeavor to bolster up this claim the specification was amended by adding the following paragraph thereto:

“The sheet of translucent material is not cut out the shape of the letter but covers the entire area defined by the length and breadth of the letter or character. By thus making the sheet of translucent material cover the entire outer area of the character without conforming to the outline of the letter the cost of manufacture is reduced while the structure is actually stronger.”

This amendment was filed without even the support of a supplemental oath.

A moment's reflection will suffice to show that a glass cannot be placed “in the plane of the sheet metal front” of a letter unless that glass be cut to the exact shape and size of the letter (the letter “I” is the only exception). However, Hotchner's claim 4, unlike his claims 1, 2 and 3, very particularly specifies that the glass shall cover “the entire area of the space bounded by the greatest length and breadth of the letter back of the same,” intending thereby that any straight-sided rectangular glass of sufficient length and breadth to cover the overall length and breadth of the letter will suffice.

Defendant's expert, Tracy W. Simpson, pointed out this difficulty of the Hotchner patent in his testimony, and the following is quoted from his deposition (R. 268-270):

"Except where a single *block letter* I or a like solid rectangular character is used, it is mechanically impossible, according to the construction shown and the description in plaintiff's patent, to use a sheet of translucent material lying 'in the plane of the metal front,' which need not be cut out to the shape of the letter, and, at the same time, may cover 'the entire area defined by the length and breadth of the letter.' (Hotchner patent, page 1, lines 62-65). It is well known that every letter of the alphabet, except I, is either re-entrant, like the letters H, E, F, G, M, etc., or contain center like the letters R, O, A, B, P, etc., which centers must be supported. In either case the re-entrant portions or the center portions absolutely prevent the use of a plain, rectangular sheet of glass, which at the same time is to lie in the 'plane of the metal' from which the molding is stamped.

"The only way that the glass could lie 'in the plane of the metal' from which the border is stamped would be for the glass to be cut out, before being assembled into the sign, into a shape exactly like the letter, and this applies equally to a construction according to Figs. 1 and 2 or Figs. 3 and 4 of the Hotchner patent. As a matter of fact in an effort to reconcile the description in the Hotchner patent above quoted (page 1, lines 62 and 71) with the rest of the Hotchner patent specifications and drawings. I did considerable experimental work in an effort to produce a sign in which the translucent material was not cut to the shape of the letter 'but covers the entire area defined by the length and breadth of the letter

or character' and at the same time had the sheet of translucent material 'in the plane of the sheet metal front,' and it proved to be an impossibility; the only exception being where the Figure was a true rectangle like the Block Letter I or a rectangular hyphen.

"It, therefore, is seen that any reference in the specification (209) to the use of a sheet of translucent material not cut out to the shape of the letter but of an area corresponding to the length and breadth of the letter is not only erroneous but inconsistent with the rest of the Hotchner specification and with the drawings, except with respect to the single character which may be called a Block Letter I."

It is important to note that claim 4 of this patent, as well as the assertion in lines 62 to 71 of the specification to the effect that the sheet of translucent material covering the entire area defined by the length and breadth of the letter or character, could be used, were introduced for the first time by an amendment, dated January 9, 1917, more than two years after the application for patent was filed, and without the formality of filing a supplemental oath. Hotchner had evidently become familiar in the meantime with the so-called Prismatic sign (defendant's Exhibit A-6), and not realizing that such signs were a part of the prior art, he attempted by amendment to bring them within the scope of his patent, and in this he was favored by the fact that, while the new claim which he introduced would be utterly inapplicable to most of the letters of the alphabet, nevertheless, it was readable upon the letter "I" shown in his drawings.

LAW REGARDING "NEW MATTER."

The law is clear that the introduction of new matter into a patent application invalidates any claim directed thereto. This defense need not be specifically pleaded in the answer. (Michigan Central Railway Co. v. Consolidated Car Heating Co., 67 Fed. 121.) Walker, in his work on patents, sums up this defense as follows:

"That the invention claimed in the original patent is substantially different from any indicated, suggested or described in the original application therefor."

Concerning this defense Walker says, paragraph 450:

"It is not based on any expressed statute. Its foundation is the general spirit of the patent laws and it has been expounded in a number of cases, beginning with the case of Railway Co. v. Sayles, 97 U. S. 563."

In the case of Railway Co. v. Sayles the validity of Tanner's patent for a brake to apply to double trucks under railway cars was involved. The original application for the Tanner patent did not show a system which could be operated from one end of the car, but an amendment made some years later showed such a device, and it was said by Mr. Justice Bradley, delivering the opinion of the court, that if the amended application and model embodied any material addition to or variance from the original, such addition or variance could not be sustained on the original application:

“The law does not permit such enlargements of an original specification, which would interfere with other inventors who have entered the field in the meantime, any more than it does in the case of reissues of patents previously granted. The court should regard with jealousy and disfavor any attempts to enlarge the scope of an application once filed, or of a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alteration or to appropriate that which has in the meantime gone into public use.”

The decision in *Michigan Central Railway Co. v. Consolidated Car Heating Co.*, supra, is by Taft, Lurton and Severns, and contains an exhaustive analysis of the pertinent decisions on this point. In that case the patentee Cody was claiming a heating system for railway cars. The steam pipes beneath the cars were shown in his drawings as being parallel with the floor of the car and in a subsequent amendment he altered his specification so as to refer to inclined pipes, the purpose of which was to get rid of air pockets and condensation. The claim in suit likewise called for inclined pipes. In holding the claim invalid the court said:

“Counsel for the appellee, in discussing this subject, and excusing the insufficiency of the drawings to show this feature of the patented device, urges that they do not prevent ‘such variations in an apparatus, in form, shape, and proportions, as common sense or mechanical skill in that art would suggest. Rather, they are addressed to persons skilled in the art, who can supplement them with their technical knowledge.’ Admitting this to be so,

and to be applicable to the written specifications also, still it carries the doctrine to its verge; and if the drawings and specifications fail to indicate the device to those conversant with the art and having the mechanical skill peculiar thereto, they are insufficient, and the patent does not include the device. Applying this as a further test, and bearing in mind what has already been said by us, and claimed by the counsel for the appellee, in respect to the problem of getting rid of pockets of air and the water of condensation, the conclusion is inevitable that the taking into the combination of the element of coils of pipe so arranged as to get rid of the difficulty was something new. Would it naturally occur to one possessing merely mechanical skill to arrange the coils in the effective way shown in the patent? If so, then there was nothing new, in the nature of invention, in the matter covered by the claim, for the obvious hints to the mechanic existed in the systems proposed to be improved upon. If not, it is clear that the invention was that shown by the amendment of the specifications, and only that. The combination is useless without that feature, and the bringing it in would be the last step in reaching success. If it was invention, it was an invention not hinted at in the original application; and, if the patent is to be restricted to the substance of that application, the claim is invalid because the invention was not useful."

This same rule has been applied in numerous cases in the Federal Courts and was reiterated by the Supreme Court in the recent case of *Stewart v. American Lava Co.*, 215 U. S. 161. In the latter case the Dolan patent for a Burner Tip was in-

volved. The structure shown in the original drawings had not been altered in any respects, but the theory of operation was changed considerably by process of amendment. Mr. Justice Holmes, delivering the opinion of the court, found the patent invalid, saying:

“It appears to us plain that Dolan’s attorney introduced not merely the theory, but the mode of applying it, for the first time, in the amended specification; or, in other words, then for the first time pointed to an invention, the essence of which was to have so short a chamber or cylinder as to prevent the mixing of the air taken into it, and to emit the current of gas surrounded by the greater part of such air as an envelop or film. Of course, Dolan desired to produce the result which the patented article is said to produce, but, beyond that desire, his specification did not give a hint of the means by which it now is said to be achieved. It spoke, it is true, as we have said of producing a hollow-shaped funnel flame by reason of the gas being forced through contracted openings at very great pressure. But this did not disclose the invention, and was dropped in the amendment. He made no claim for a process and disclosed no invention of a device. This being so, the amendment required an oath that Dolan might have found it difficult to take, and for want of it the patent is void.”

Hotchner’s failure to illustrate and describe the structure called for by claim 4, aside from the foregoing objection, constitutes a fatal defect in that he has not complied with the provisions of section 4888, Revised Statutes, which requires that the manner and process of making, constructing, com-

pounding and using an invention shall be described in such full, clear and concise and exact terms as to enable any person skilled in the art to make, construct, compound, and use the same. Concerning this defense Walker says:

“If a patent falls below the statutory requirement in that respect that patent is void,”

citing *O'Reilly v. Morse*, 15 Howard 62.

The case of *O'Reilly v. Morse*, as is well known, involved the Morse patent for a telegraph. Chief Justice Taney, in finding the 8th claim of the Morse patent invalid, said:

“This claim can derive no aid from the specification filed. It is outside of it and the patentee claims beyond it. And if it stands it must stand simply on the ground that the broad terms above mentioned were a sufficient description and entitled him to a patent in terms equally broad. In our judgment the act of Congress cannot be so construed.”

The case of *Pacific Cable Railway Co. v. Butte City Railway Co.*, 58 Fed. 420, is also in point. The patent in suit had to do with a turn-table for cable cars and described the use of turn-tables in duplicate. The claim was broad enough to cover the use of a single turn-table, but the description and drawings failed to show how a single turn-table might be used in transferring a car from one track to another. The court, in refusing to find infringement of the patent where a single turn-table was used, referred to the language of section 4888, and said:

“In turning to the Statute above quoted it will be seen that the manner of using an invention must be given in the description and in such full, clear, and concise and exact terms as to enable any person skilled in the art or science to which it appertains or with which it is most nearly connected to use the same. While the claim may be broad enough there is no description of how one table is to be used except in connection with the other. If a claim is not properly described in a patent the claim is of no validity.”

The same facts apply to Hotchner's patent where he shows and describes one manner of constructing and assembling his sign and in claim 4 calls for a structure quite different and in fact repugnant to the one shown and described. There is no full, clear and concise description of the manner in which he constructs a sign such as is called for in claim 4, and hence under the Statute the claim is invalid.

Re: Prior Art:

This brings us to a consideration of the prior art, and more especially to the Prismatic Signs above referred to.

The Prismatic Sign was designed and built by the Prismatic Sign Company, of Denver, Colorado, a firm consisting of Archibald MacKenzie and Thomas M. Norton. The depositions of both partners, as well as that of Clark Rider, the user of one of the said Prismatic Signs, are in the record (pp. 81 to 134). The character of the letter therein is

shown by defendant's Exhibit A-6, which is one of the letters taken from a sign erected by the Prismatic Sign Company, in Denver, Colorado, on or about October 15th, 1912, which is more than two years prior to the filing of the application for the Hotchner patent.

An examination of this exhibit will show that it is in all essentials like defendant's signs, and that it has a raised molding forming the border of the letter and that it is backed by a sheet of glass or translucent material covering the entire area of the space bounded by the greatest length and breadth of the letter.

If defendant's sign comes within the scope of Hotchner's claim 4, then so does the Prismatic Sign (defendant's Exhibit A-6), and, since it is axiomatic that that which infringes, if later, invalidates, if earlier, then Hotchner's claim is invalid.

In regard to the date of the erection of the Prismatic Sign (defendant's Exhibit A-6) plaintiff's counsel stated to the court (R. 316):

"I might say, your Honor, in respect to this particular sign, this is the only sign whose public use is proved definitely as being more than two years prior to the filing date."

Plaintiff then produced a single witness, namely, C. B. Thorne, in an effort to show that the raised molding forming a part of the Prismatic Sign in evidence had been put on after the sign was erected. Thorne's testimony was to the effect that he was a Deputy Electrician for the City of Denver in 1912,

and as such inspected a sign in front of the Denver Electrical Company, which sign, according to his recollection, did not have a raised molding around the letter. On cross-examination Thorne admitted that he had inspected but one sign in front of the Denver Electrical Company, whereas the record shows that the Denver Electrical Company purchased two different signs from the Prismatic Sign Company at or about this time, one with raised molding and one without.

The proofs bearing upon the origin of this sign, defendant's Exhibit A-6, are overwhelming. At a session in Denver, Colorado, the following witnesses were called by defendant: Otis B. Spencer, Archibald MacKenzie, Thomas M. Norton and Clark Rider.

Spencer is Permit and Certificate Clerk in Department of Improvement of Parks, City of Denver, and has been so engaged for some twelve years or more. He produced his official records showing applications for permits to erect electric signs; also certificates of electrical inspection pertaining thereto. The following were read into the record: Permit No. 2894 pertaining to the New York Floral Co. sign, showing application for permit, dated July 29, 1912, and issuance of permit, including certificate of inspection, dated August 17, 1912. Exhibit A-1 is a copy. This permit was prepared under the hand of Spencer and Exhibit A-7 is a photostat of the original permit. Permit No. 2951 covering DuBois sign showing application dated

August 27, 1912, and issuance of permit, including certificate of inspection, dated September 3, 1912. Exhibit A-2 is a copy of same prepared under the hand of Spencer and Exhibit A-8 is a photostat of the original Permit No. 3794 relating to the Denver Electrical Co. sign showing application dated July 31, 1912, and issuance of permit, including certificate of inspection, dated October 14, 1912. Exhibit A-3 is a copy of same prepared under the hand of Spencer and Exhibit A-9 is a photostat of the original. (Record pp. 65-80.)

McKenzie, who testified in San Francisco, resumed his testimony in Denver and identified the applications for permits referred to in the deposition of Spencer, and testified that said applications were in his handwriting and were prepared on the dates shown on the upper right-hand corners thereof. McKenzie described the signs in detail and testified that the New York Floral Co. and DuBois signs were no longer in existence, but that the Denver Electrical Co. sign was still in use and in nowise changed in construction. At the request of defendant's counsel an adjournment was taken to inspect Denver Electrical Co. sign, and the letter "O", occurring in said sign, was removed and offered in evidence as Exhibit A-6. (Record pp. 81-85 and 127-128.)

Norton was a partner of McKenzie in Prismatic Sign Co. and recalled the Denver Electrical Co., New York Floral Co. and DuBois signs referred to in the foregoing permits. He described the pro-

cedure necessary to get a permit to erect a sign in Denver, stating that the sign must be completed and inspected before the permit is granted. After the permit is granted the sign is hung within two or three days. He identified the Denver Electrical Co. sign by reference to photographic Exhibit A-4 and sample Exhibit A-6, stating that it was the same as when originally hung and that the New York Floral Co. and DuBois signs referred to above were of identical construction. (Record pp. 85-105 and 124-126.)

Rider is the owner of the Denver Electrical Co. He testified that the sign shown in photograph Exhibit A-4 and sample Exhibit A-6 was hung in front of his place of business about October 15, 1912, by the Prismatic Sign Co. and that the said sign had not been altered in construction since that time. (Record pp. 105-124.)

Defendant's witnesses, MacKenzie, Norton and Rider all testified that within a space of several months two different signs were erected for the Denver Electrical Company containing substantially the same reading matter, one with raised molding and the other without. The sign from which defendant's Exhibit A-6 was taken is shown by the official records of the City of Denver to have been inspected and approved on the 14th day of October, 1912, the application for permit to hang the same having been applied for on July 31, 1912. (Def'ts Exhibit A-3.)

The sign which did not have the raised molding was erected some six months earlier. Mr. MacKenzie's testimony on this was as follows (R. 178-180):

“Q. You stated that you erected a second sign for the Denver Electrical Co. When was it erected?

A. About six months later, to the best of my recollection.

Q. How did these two signs compare which were erected for the Denver Electrical Co.?

A. The first sign we erected for them was for an electrical show in the auditorium; after we got through with that we hung one over their door, their working place, their shop where they made the fixtures, and had us make a more elaborate one later to go over their showroom.

Q. Were the two alike in construction and appearance?

A. One had a rim-letter; the first sign did not.

Q. By a rim, what do you mean?

A. A metal flaring border around the letter.

Q. Which one had the flaring metal border around the letter? A. The latter one.

Q. That was erected, you say, approximately six months after the first one?

A. I say in June or July, along there, 1912.”

It is further to be noted that all three witnesses, namely, MacKenzie, Norton and Rider testified that no changes whatever had been made in the sign (defendant's Exhibit A-6) since the time it was erected, except to paint the same. Surely the testimony of a single individual having but a casual knowledge of one of two signs bearing the same legends cannot in any way cast doubt upon the

testimony of three others who were familiar with both signs and took part in erecting and maintaining the same.

OREGON HOTEL PRIOR USE.

There has also been introduced in evidence photographs of the Oregon Hotel sign (defendant's Exhibit DD) which also embodies the essential features of both plaintiff's and defendant's signs. Its border or outline molding is somewhat differently shaped, but it has a raised effect and it has a glass back of the character covering the entire area of the space bounded by the greatest length and breadth of the letter, and also is lighted from the interior. The date of erection of this sign is fixed by the witnesses Heft, Zancker and Anderson as having taken place in September, 1911.

LOS ANGELES PRIOR USE.

There is also a White Sewing Machine Company sign (defendant's Exhibit B). It is constructed substantially in accordance with an expired patent to Hotchner, namely, Patent No. 769,139, dated August 30, 1904, and has been in continuous use in Los Angeles, California, since the beginning of 1914. It differs from defendant's sign merely in the use of a wooden molding in place of a metal molding and the translucent material is a screen rather than glass. However, plaintiff's counsel ad-

mits that to substitute a metal border for a wooden molding or glass for a screen would not amount to invention:

“The COURT. Do you claim that the change from wood to some other material is invention?

Mr. GRIFFIN. Not put in that way, your Honor. What we claim is that what claim 4 of this patent discloses is a valid invention, to-wit, all of the construction mentioned in that claim. We do not claim that simply changing from wood to metal——

The COURT. Or from wire to glass.

Mr. GRIFFIN. Or from wire to glass, is an invention. It requires the entire series of elements recited in the claim to make the invention valid.” (R. 297-98.)

PRIOR ART PATENTS.

Further, we have the sign of the Little patent, No. 32,195, dated April 30, 1861, an embodiment of which is found in defendant's Exhibit BB. It differs from defendant's sign only in the fact that the front is made of wood instead of sheet metal. Also there is a French patent to Boldes, No. 335,943, dated September 17, 1903, an embodiment of which is found in defendant's Exhibit CC. It differs from defendant's sign merely in the fact that it has a glass front which, except for the part defining the letter, is intended to be made opaque in any suitable way. By covering the unused portion of the glass with a coat of paint or other shield a striking resemblance to defendant's as well as to plaintiff's sign is produced.

IMMATERIALITY OF HOTCHNER 1910 PROOFS.

Hotchner, on rebuttal, attempted to carry the date of his invention back to 1910 or some four years before he applied for his patent. Even if successful in this attempt, it would not avail him anything as against such prior uses as the Prismatic Sign and the Oregon Hotel sign, both of which are definitely proven as having been in public use for more than two years prior to the filing of Hotchner's application for patent.

Under Section 4920 R. S. the patent is invalid whenever the invention covered thereby has been in public use for more than two years prior to the filing of the application for patent regardless of the date when the alleged invention was made.

Hotchner's testimony as to what he did in 1910 is not very convincing. He claims to have constructed a letter having a raised molding, which molding differed considerably from the molding shown in the Hotchner patent. Nothing was done with this device until December 5, 1913, at which time Hotchner claims to have received an order from one Max L. Shirpser to construct a sign of a similar nature. There was no testimony offered as to the date when said Shirpser sign was constructed and erected.

The following admission made by Hotchner on cross-examination shows clearly that he is not entitled to any credit for anything he might have done in 1910 for the reason that he was lacking

in diligence, and apparently concealed or suppressed the alleged invention:

“A. The first sign I sold was the Shirpser sign.

Q. Prior to that time you had done nothing with it?

A. Prior to that time I had done nothing with it.

Q. You merely stored it away and left it?

A. That is all.” (Record p. 303.)

It is important to note that Hotchner’s testimony as to what he did in 1910 related to a sign having its border or outline molding soldered in place rather than being made integral with the sheet metal front, as by pressing or forming. Much stress was laid upon the pressed border or outline molding in the specification of the Hotchner patent, and, in his claims 1, 2 and 3, as will be seen by the following statement by defendant’s expert, Tracy W. Simpson:

“Referring to the patent specifications, the patentee says (page 1, beginning line 41):
* * * the letter construction is the important feature of the present case.

The patentee then goes on to state that this letter construction of his consists in so acting upon a sheet of metal as to press outwardly therefrom a molding ‘having an outwardly flared surface at 12, which molding will have the shape of the desired letter.’ It is thus to be seen that the letter, or the molding defining the letter or border, is produced by pressure, presumably by a metal press or die.

Continuing the patentee says (page 1, lines 51 to 57):

‘This molding is pressed outwardly far enough so that a suitable sheet of translucent material 13 may be inserted under the molding and is held in place in the plane of the sheet metal front 10 by strips of sheet metal 14, soldered or otherwise secured to the inside of the front 10.’

‘In the mechanical arts ‘pressing’ means ‘stamping’ or drawing in a flat bed machine, in which the metal is stretched into various shapes, whereas by the process of ‘forming’ we mean ‘bending’ or ‘shaping’ without necessarily producing stretching or drawing of the metal, but merely bending of same. From this view-point the Hotchner border could be produced only by ‘pressing’ in a drawing press or ‘forming’ by special tools out of the sheet metal constituting the front of the sign.”

Evidently Hotchner did not consider that he had made any invention until he arrived at the “pressed border” stage some time in 1914. Hence, the reason for his not filing an application for patent at an earlier date.

Surely, plaintiff is without grounds to argue that he has a patent of such scope as to cover defendant’s sign, and the trial Judge was correct in ruling that plaintiff’s contentions were utterly unfounded.

Re: Patent No. 1,315,187, dated September 2, 1919: (Sidewalk Illumination).

Infringement of this patent is predicated upon claims 1, 2 and 3, which, segregated into their various elements and conditions, are as follows:

Claim 1:

In an illuminated sign,

- (1) a sign body,
- (2) a lamp located within said body
 - (a) to illuminate a character carried thereby,
- (3) a lamp below the first lamp
 - (a) to illuminate the sidewalk below the sign,
- (4) and means intercepting the rays from the latter light
 - (a) when the sign is observed at some distance horizontally therefrom.

Claim 2:

In an illuminated sign,

- (1) a sign body,
- (2) a translucent character carried thereby,
- (3) a concealed light
 - (a) to illuminate said translucent character,
- (4) a reflector below the lamp
 - (a) to direct the light from said lamp through the character,
- (5) and another light upon the opposite side of said reflector from said first lamp,
 - (a) for illuminating the sidewalk below the sign.

Claim 3:

In an illuminated sign,

- (1) a sign body,
- (2) a translucent character carried thereby,
- (3) a lamp within the sign body
 - (a) to illuminate the character,
- (4) a reflector to direct the light from said lamp through the character,
- (5) and another light adjacent said reflector,
 - (a) so placed that the rays therefrom will strike the opposite side of the reflector and illuminate the sidewalk below the sign.

The meaning of claim 1 is not at all clear. It specifies a notoriously old type of sign having an upper row of lamps to illuminate the sign character and a lower row of lamps to illuminate the sidewalk and "means intercepting the rays from the latter light when the sign is observed at some distance horizontally therefrom." Any sort of a trough or reflector will intercept rays of light in the manner specified and would be a necessary adjunct where it was desired to reflect light downwardly to the sidewalk, since, naturally, it would be wasteful to have this light scattered in a horizontal direction.

Claims 2 and 3 include very clearly the use of a reflector for the lower row of lights, which reflector has a two-fold function:

(a) to reflect the light from the bottom row of lamps down on to the sidewalk, and

(b) to reflect the light from the upper row of lamps out through the sign character.

This is not a patentable combination, but is what is recognized in patent law as an *aggregation*, that is making one end or side of an article perform one function and the opposite end or side some other and decidedly different function, as in the case of the rubber tipped pencil. *Reckendorfer v. Faber*, 92 U. S. 357.

Two reflectors, each entirely separate and independent of the other, would accomplish the same result, and in effect, that is what Hotchner has, since each face of the trough constitutes a reflector which is entirely independent of the opposite face. In other words, if we take away the upper reflecting surface, we do not in any way impair the operation of the lower reflecting surface, and vice versa.

Re: Aggregation:

The law on this subject is well settled and the dividing line between combinations and aggregations is well established. *Walker* 5th Ed. p. 40.

The distinction between a combination and an aggregation lies in the presence or absence of mutuality of action. To constitute a combination it is essential that there should be some joint operation performed by its elements, while in an aggre-

gation there is a mere adding together of separate contributions, each operating independently of the other. *American Chocolate Machinery Co. v. Helmsstetter*, 142 Fed. 979 (C. C. A. 2nd Cir.).

To determine on which side of the line any particular case belongs may sometimes present difficulties, but in the instant case there are so many precedents to be found in the decisions of the Supreme Court and of this court directly in point that the question is free from any doubt.

The features of defendant's device alleged to constitute an infringement of this patent comprise an interiorly lighted electric sign having means for illuminating the sidewalk and store front without destroying the effect of the sign. This is accomplished by providing an additional lamp arranged in the bottom of the sign and fitted with a trough-shaped reflector so that its light shines downwardly rather than horizontally or upwardly. The light for illuminating the interior of the sign remains unchanged and is in nowise affected by the presence of the lowermost lamps. The particular trough-shaped reflector is notoriously old, so old in fact as to call for the exercise of judicial notice. It is frequently seen in use on theatrical stages where it is arranged between the wings and drops of the stage.

A familiar example of an aggregation is that involved in the case of *Reckendorfer v. Faber*, 92 U. S. 357 pertaining to the rubber tip pencil. Millions of these articles had been made and sold

under the patent, but the Supreme Court held the patent void for aggregation, calling attention to the fact that there was no joint operation performed by the pencil and the rubber.

Another case, reported in 114 U. S. 149 involved a patent for combining a mirror with the front hood of a street-car and so locating the mirror with respect to the glass door in the front end of the car that the motorman or driver could observe all that took place on the rear platform. It was a valuable scheme and is used extensively even today in automobiles. The Supreme Court in holding the patent invalid, said:

“The elements of which the combination described in this patent is composed are all old and well known. They were a mirror, the hood of a street car over the driver’s platform, and a glass panel in the front end of the car over the door. We are of opinion that the alleged combination of these three elements, as described in this patent, is not patentable. There is, in fact, no combination, but a mere aggregation of separate devices, each of which performs the function for which, when used separately, it was adapted, and does not contribute to any new result the product of their joint use. The result attained is merely the reflection of an object in a mirror. The hood and the glass panel in the end of the car do not change in any degree the function of the mirror. It is used as a mirror only. The function of the hood is not changed by the mirror or glass panel, or both. It is a hood only on which, as in the wall of a room, the mirror is hung. The use of a glass instead of a wooden panel in the front end of the car simply removes an opaque obstacle between

the mirror and the object to be reflected by it. Neither one of the three elements of the alleged combination performs any new office or imparts any new power to the others, and, combined, they do not produce any new result or any old result more cheaply or otherwise more advantageously. There is, therefore, no patentable combination.

In the case of *Adams v. Stamping Co.*, 141 U. S. 539 the plaintiff claimed a patent for the combination of various elements with a lantern including a hinged metallic top. Similar lanterns with removable tops not hinged were known in the prior art and the court held the patent invalid for aggregation. At the trial in the lower court plaintiffs offered proof to show that the patented lantern had superseded all others and requested the trial Judge to instruct the jury that such great commercial success was strong evidence of invention and further requested the court to instruct the jury that before the patent could be held invalid it was incumbent upon the defendant to prove a prior structure or patent having all the elements of the combination combined in substantially the same manner as shown in the patent. These instructions the Judge refused to give and the Supreme Court, in sustaining the trial court, said:

“The court did not, therefore, err in refusing the instruction requested, that before the patent could be held invalid by reason of a prior patent it was not sufficient to find one of the elements in one patent, a second in another, and a third in another. If the patent were for a combination of new or old elements

producing a new result such instruction might have been correct, but as it was merely a new aggregation of old elements, in which each element performed its old function and no new result was produced by their combination, the instruction was not applicable and was properly refused.

“Nor under the circumstances did the court err in declining to instruct the jury that the fact that the Irwin lantern had practically superseded all others was strong evidence of its novelty. The question before the court upon the main issue was not of the novelty of the invention but rather of its patentable character. Where there is no invention the extent of the use is not a matter of moment.”

The rule as to aggregation and its application to the present case is also illustrated in *Grinnell Washing Machine Co. v. Johnson*, 247 U. S. 426, decided June 10, 1918, where Mr. Justice Day, after stating the rule as previously laid down in *Richards v. The Chase Elevator Co.*, 158 U. S. 299; and *Specialty Co. v. Fenton*, 174 U. S. 492, went on to say:

“Applying the rule thus authoritatively settled by this court, we think no invention is shown in assembling these old elements for the purposes declared. No new function is ‘evolved from this combination’; the new result, so far as one is achieved, is only that which arises from the well-known operation of each one of the elements.”

Re: Non-Infringement:

Disregarding the apparent illegality of this patent, and assuming, for the sake of argument, that

it is valid, it is shown by the record that defendant does not infringe, since the bottom reflector in defendant's sign does not in any way reflect light through the characters in the main body of the sign. Defendant's expert, Tracy W. Simpson, brings this out clearly in his testimony in explaining the operation of defendant's sign (Exhibit "EE").

"A. There are two reasons why no light could be reflected from the lower reflector onto the characters of the sign; the first reason is that we have been careful to provide sufficient lamps behind the characters, providing usually one at the top of the character and one at the bottom, so that the lights provide all of the illumination necessary for the character, both top and bottom. Another reason is that the lower reflector is so far down in the body of the sign, so far away from the upper portion of the sign that by no possible chance could the light be reflected backwards to illuminate the lower portion of the characters on the side."

Testifying in regard to an illustrative drawing (defendant's Exhibit FF) the witness Simpson said:

"This drawing is a correct representation to scale of the Normal Pharmacy sign. It is a section view.

Q. The red lines represent what?

A. The red lines represent rays of light coming from the centers of the filaments of the two incandescent lamps; it will be observed that these red lines are shown to impinge the lower reflector and under the well-known optical principle that the angle of incidence must always equal the angle of reflection it will be seen that there is no possible way by which

light may be reflected from the upper side back upward into the body of the sign, and in no way assist in lighting the characters on the side of the sign. Those light rays dissipate themselves on the lower crevices of the body.

A. (continuing) If one were to draw an imaginary line, he would have in the upper part an electric sign, just the same as if it had been made in Seattle under the Seattle ordinance, and in the lower part he would have a border or strip of light, which is notoriously old." (R. 259-261.)

Quite plainly, plaintiff never inspected closely nor ascertained the position of defendant's lower reflector with relation to the characters in the main body of the sign. Plaintiff tried to prove infringement by the testimony of the witness, Joseph Hotchner, who, on cross-examination, disqualified himself as follows:

"Mr. LOFTUS. Q. Did you take any measurements of those signs that are shown in this photograph, exhibit 7?

A. What measurements?

Q. The interior dimensions of the signs.

A. No, I didn't take any measurements of the interior.

* * * * *

Q. You stated that you made no measurements of the interior of these signs. Did you make any measurements of the exterior?

A. No.

Q. You don't know the height of the letters?

A. No, I do not.

Q. You don't know the depth of the trough, the bottom reflector, do you?

A. Yes, it is about 6 inches deep.

Q. Did you measure it?

A. No, I didn't. I don't have to measure a little thing like that, you can tell by your eye.

Q. You guess at it? A. Yes.

Q. And you didn't examine the interior of the sign?

A. The exterior building of the sign——

Q. Just a moment; I say, you didn't examine the interior of the sign? A. No, sir.

Q. Did you measure the distance between the bottom of the letters at each side of the sign, the bottom line of letters reading, 'Normal Pharmacy', did you measure the distance between that bottom line and the lowermost reflector which illuminates the sidewalk?

A. No, I did not." (R. 47-48.)

The well known law of physics that the angle of reflection is equal to the angle of incidence makes important the question as to just what position the bottom reflector occupies with relation to the characters in the main body of the sign in order to determine whether or not light will be reflected through said characters by the back or convex side of the bottom reflector. After failing to prove this as a part of his prima facie case, plaintiff's counsel sent two of his representatives to examine defendant's sign and called them to the stand on rebuttal. Even so, they failed to give exact measurements and attempted to substitute mere opinion evidence. See the depositions of witness Boylan and witness Meeks. The following shows the gist of Meek's testimony in this regard:

"Q. Since the morning session of this court, did you go over to Oakland and examine the signs testified about this morning? A. I did.

Q. Did you look inside there? A. Yes, sir.

Q. I will show you a photograph heretofore offered in evidence, carrying the words, 'Harry Rose, Haberdasher', and 'Al. Chase, Clothier', and ask you with respect to the lower line of letters reading 'Al. Chase, Clothier', whether or not, in your opinion, it is possible for light proceeding from the upper lamps to be——

A. In my opinion it does reflect." (R. 319.)

Witness Boylan's testimony is as follows:

"Q. Could any light from the interior of the signs pass against the reflectors at the bottom of the sign and through the letters 'Al. Chase, Clothier'?

A. I don't think I know what you mean. Do you mean the light from the letters that throw out onto the sidewalk?

MR. GRIFFIN. No, I mean the light from the inside of the sign proceeding down against the inside reflector here which is shown in this photograph, and then from there against the letters 'Al. Chase, Clothier'.

A. I believe it could.

THE COURT. This question is susceptible of demonstration, and should not depend on the hap-hazard testimony of witnesses. Proceed." (R. 320-21.)

As against this conjectural and opinion evidence is the positive fact testimony of Tracy W. Simpson, who, on cross-examination, testified as follows (a photograph of one of defendant's signs bearing the legend "Al. Chase, Clothier" being then under discussion):

"MR. GRIFFIN. Q. How high would you say those letters were from the bottom of the sign?

A. Approximately 7 inches.

Q. Is it not a fact that the reflector inside of the sign is more than 7 inches deep?

A. No, sir. We measured that very particularly since this came up.

Q. How deep into the sign does that reflector go?

A. I don't recall the exact figure as to the distance from the lower line of the lower line of letters to the bottom edge of the sign, and the exact distance upwards that the reflector extends into the sign, but I do recall particularly that the difference between those dimensions was from one-half to three-quarters of an inch; that is to say, the distance upward from the lower line of the lower line of letters above the edge of the sign is one-half to three-quarters of an inch higher than the vertical height of the reflector upwards into the sign.

Q. That very fact would not preclude the reflection of some light from that reflector as it might in a sign such as you have shown here, where the height above the reflector of the bottom of the letter is approximately two inches?

A. It would preclude it; there is no possible way that that light could be reflected backwards up into the sign from a reflector, when the upper line of reflector is lower than the lowest line on the characters themselves.

Q. Is it not a fact that the light would be reflected into the body of the sign, and then back to the other side, and then out to the letters on the opposite side, if there were any?

A. No, sir, not with that form of construction." (R. 289-90.)

From the foregoing it is quite obvious that even if plaintiff had a valid patent covering the use of a bottom reflector which will reflect from one set of lamps downwardly and from another set upwardly and outwardly through the main character in the body of a sign, defendant does not infringe, inas-

much as the latter function is not present in defendant's signs.

Re: Prior Art:

As the trial judge stated at the conclusion of the trial the mere mode employed to throw rays of light from a sign down to a sidewalk could not be made the subject of a patent monopoly at the time Hotchner applied for his patent. This seems so self-evident that one hesitates to refer to prior patents or prior uses showing such a thought to be old. However, the record is not lacking in this regard, as will be seen from the following quotation taken from the deposition of defendant's expert, Tracy W. Simpson:

“ ‘Various municipalities have for a long time had ordinances requiring sidewalk illumination in connection with all electric signs, and particularly signs of the interior-lighted type. This is especially true of Seattle, Washington, and Los Angeles, California, in the territory where the company of which I am Vice-President and Western District Manager operates. For instance, Ordinance No. 21308 of the City of Seattle, Washington, which has been in effect since August 8th, 1909, has at all times required that:

“ ‘Electric signs made entirely of galvanized iron, letters forms on each side of the sign, with one (1) and two (2) inch glass screw lenses, the two inch lenses with not less than a four (4) inch center, apart, and the one inch lens not less than a two (2) inch center, apart, illuminated from the inside with not less than two hundred (200) candle power to each sign, and more, if the size of the sign shall require,

bottom of sign left open to illuminate the sidewalk; will be allowed to be constructed and hung as provided for electric signs in this ordinance and as further set forth in this section.'

" 'The purpose of the requirement that the bottom of the sign be left open is to illuminate the sidewalk, and such requirement is satisfied by providing a separate set of lights to illuminate the sidewalk. In connection with such separate set of lights, it has long been the practice to provide a reflector which will direct the rays therefrom downwardly to the sidewalk.' " (R. 279-80.)

* * * * *

" 'I have examined United States patent No. 775,295 to R. W. Clark, dated November 22d, 1904, and understand the structure therein shown. It comprises a sign body A which carried at each side a sign character 4. At the bottom of the sign body there is a row of lamps 11, in connection with which there is arranged a reflector having a surface 8 to direct the light from the lamps downwardly. This reflector constitutes means for intercepting the rays from the lower lamps when the sign is observed at some distance horizontally therefrom.

" 'I have also examined United States patent No. 1,070,028 to Fortman, filed December 6th, 1912, and issued August 12th, 1913, and understand the structure shown and described therein. It is primarily intended for a signaling device, but embodies principles and structural features equally applicable to any form of illuminated sign. It comprises an illuminated sign consisting of the letter "L" and "R" (Fig. 1). These letters are illuminated by lamps contained in compartments 6 and 7. Beneath the compartments 6 and 7 there is a lamp arranged in a compartment 8 to illuminate the ground and license plate. By means of the

opaque glass front 23 and the inside partition 4 the rays from the lowermost lamp are intercepted so that the latter light will not be seen when the sign is observed at any distance horizontally therefrom.' '' (R. 281-82.)

APPELLANT'S ARGUMENT.

Appellant's brief presents two alleged points of law as a basis for asking this court to reverse the decision of the trial court. Point No. 1 has to do with the date when Hotchner claims to have made his alleged invention of the first patent in suit, to-wit, the raised molding patent. Point No. 2 complains that the decision of the trial court went beyond the matter in issue. There is a third point which appears to be interwoven with point No. 2, merely stating the same criticism in another way.

By his first point appellant's counsel apparently contends that what Hotchner claims to have done in 1910 by way of making a model eliminates in some unexplained way all of the prior patents and prior uses which defendant has offered. It is difficult to follow this argument for it fails to take into consideration the effect of the Little patent of 1861, the French patent to Boldes of 1903 and the White Sewing Machine Company sign, which is simply a physical embodiment of the expired Hotchner patent No. 769,139, dated August 30, 1904, all of which are anterior to the earliest date claimed by Hotchner.

The contention of appellant also fails to take into consideration the effect of a prior use occurring more than two years before Hotchner's filing date. It is immaterial when Hotchner made his alleged invention if it be proven that a similar device was known to others and was in public use or on sale for a period of two years prior to the filing of the application for patent in suit. Such is the status of the Oregon Hotel sign and the Prismatic sign. Great reliance is placed by appellant on the haphazard testimony of a former inspector by the name of Thorne relative to the Prismatic sign.

Under cross-examination Thorne disqualified himself when he admitted that he was familiar with but one of two signs erected by the Prismatic Sign Company for the Denver Electrical Company. It will be recalled that there were two different signs erected for the Denver Electrical Company by the Prismatic Sign Company within a comparatively short time of each other, one with flat letters and the other with a raised molding around the letters. The following is quoted from Thorne's deposition at page 317:

"Mr. LOFTUS. Q. Did you know that there was more than one sign erected by the Prismatic Sign Company for the Denver Electrical Company?

A. Yes, I did.

Q. Are you familiar with both of those signs?

A. No, I am not.

Q. And you don't know from memory, now, which of these signs had the border and which did not?

A. I know that the sign that I inspected and the sign that was held up on account of permits from the Board of Public Works was all flat letters at the time it was inspected.

Q. There may have been another sign, so far as you know, that had the molding?

A. Yes, there may have been."

The second point which appellant attempts to make in his brief is that the trial court in its decision went beyond the scope of the issues. This assertion comes with bad grace in view of the repeated attempts made by the trial judge to get plaintiff's counsel to commit himself as to just what invention, if any, was supposed to be represented by each of the patents in suit. The replies of appellant's counsel were so worded as to make it clear that plaintiff's case was based upon the proposition that his first patent gave him a monopoly to the broad idea of using a raised molding around the outline of the letter, and that his second patent was such as to give him a monopoly on the broad idea of throwing light rays down from a sign whereby to illuminate a sidewalk, as will be seen by the following quotations taken from the record:

"The COURT. What is it the plaintiff claims under his patent—the exclusive right to use this?

Mr. TOWNSEND. Apparently, from the prima facie case, they claim any sort of a beveled border as an infringement.

Mr. GRIFFIN. We claim the right to use any kind of a raised metal molding.

The COURT. And you claim no one else has a right to use it?

Mr. GRIFFIN. We claim no one else has the right to use the metal molding in connection with this translucent letter with the illumination in the back of the character." (Record p. 239.)

The COURT. Do you claim a monopoly on the right to use a reflector to turn light down?

Mr. GRIFFIN. The witness says here, in connection with his affidavit, and I am only seeking to cover what is claimed by the two patents, this particular claim describes the location for the lights handling the sign, and also the lights for illuminating the sidewalk." (Record p. 337.)

If plaintiff had placed any narrower interpretation upon the scope of his patents, the matter of proving infringement would have been impossible, inasmuch as defendants' structures differ radically from the specific structures shown in the Hotchner patents in suit. The plaintiff, having based his case upon the proposition that his patents gave him a broad and comprehensive monopoly, ought not to complain that the trial court dealt with the patents on that basis.

It is submitted that on the record as made by plaintiff the trial court properly found the patents to be invalid and not infringed.

Dated, San Francisco,
October 21, 1922.

Respectfully submitted,

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Attorneys for Appellees.

